

REMARKS

Claim 30 is amended. Claims 10 and 27-38 are pending.

Election/Restriction Requirement

5 In the current Action, the Office withdraws newly added claims 31-38 under 37 CFR §1.142(b), stating that these claims are “directed to a non-elected invention.” (*Office Action of 01/03/06*, p. 3). As depicted below it appears—based on the Office’s added bold emphasis—that the Office believes that the inclusion of “*ink type*” in independent claim 31 and “*virtual print items*” in
10 independent claim 36 render these claims restricted and/or non-elected.

- receiving at least one order for print products on-line, said at least one order having an item requiring a particular ink type (claim 31)
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular ink type loaded onto said printer device; (claim 31)
- printing said item according to said order, with said printer device, and using said particular ink type. (claim 31)
- printing a print item according to said order; (claim 36)
- electronically arranging a plurality of virtual print items on at least one virtual media sheet (claim 36)
- re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet (claim 36).

Id. at 3-4. Applicant respectfully but forcefully disagrees with the Office’s assertion. Applicant submits that all claims are directed to an elected group, and,
15 further, that no serious burden is placed on the Office by the examination of these claims, as required for a proper restriction under MPEP 803.

First, Applicant submits that claim 31 is directed to an elected group. A proper understanding of the claimed subject matter as well as the prosecution history of this application is necessary to fully appreciate this fact.

As the Office may recall, the Office remarkably restricted the current application to no fewer than 23 different groups. (*Office Action of 03/15/05*). Even more startling, however, is that the application as filed contained no more than 26 claims. Applicant accordingly traversed the restriction (a traversal that Applicant currently maintains), but nevertheless elected to prosecute species b of Group III. Species b of Group III, as grouped by the Office, *contains only two* claims of the originally filed application, namely claims 10 and 12. Claim 12 is reproduced below, with emphasis added:

12. The method as claimed in claim 10, further comprising:

allocating a plurality of said print items to a plurality of printer devices, *taking into account for each printer device*, parameters selected from the set:

availability of said printer device;

a sheet material type loaded onto said printer device;

an ink type loaded onto said printer device;

a percentage utilization of said printer device.

As shown above, the subject matter of "*ink type*", on which the Office appears to rely in restricting claims 31-35, is clearly included in the elected species. Because claims 31-35 are directed to an elected group, the withdrawal of

claims 31-35 is improper and Applicant requests that the Office examine these claims.

Furthermore, Applicant submits that the withdrawal of claims 36-38 is also improper. First, Applicant submits that claims 36-38 are indeed directed to the
5 elected group. Second, Applicant submits that examination of these claims places no serious burden on the Office, *as required by MPEP 803*. In fact, it appears that *the Office agrees that examination of these claims lacks such a burden*.

To illustrate this point, it is first necessary to recall that the Office appears to object to the inclusion of independent claim 36 because it recites "virtual print
10 items". This objection is reproduced above. Next, it is necessary to inspect claims 29 and 36, reproduced below with emphasis:

29. (previously presented) The method as claimed in claim
10, further comprising:
15 *electronically arranging a plurality of virtual print items on at least one virtual media sheet; and*
re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

36. (previously presented) A method of providing on-line
print services, said method comprising the steps of:
receiving at least one order for print products on-line;
electronically distributing said at least one order to at least one
25 print service provider facility;
within a said print service provider facility, electronically allocating said order to at least one printer device;
printing a print item according to said order;
30 *electronically arranging a plurality of virtual print items on at least one virtual media sheet; and*
re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

As shown above, the *italicized text* of claims 29 and 36 is *identical*, both including the subject matter of “virtual print items”. Furthermore, note that the remaining, non-italicized text of claim 36 clearly falls within the originally elected group.

5 Finally, inspection of the Office’s *substantive rejection of claim 29* in the current Action completes the syllogism. This rejection is reproduced below:

As per claim 29, Blumberg discloses electronically arranging a plurality of virtual print items on at least one virtual media sheet and re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet. See for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.

(Office Action of 01/03/06). Although Applicant disagrees with the substance of the rejection, this passage proves that the inclusion of claim 36-38
10 does not seriously burden the Office as is required for a proper restriction. In other words, how can the inclusion of a claim set burden the Office when the supposedly burdensome subject matter *has already been allegedly found by the Office in a primary reference*? Applicant submits that examining claim 36 cannot impose any serious burden, and further submits that the Office impliedly agrees by
15 substantively rejecting claim 29. The Office’s inconsistency puzzles Applicant. Applicant accordingly submits that the withdrawal of claims 36-38 is improper and requests that the Office examine these claims.

In the Office's elaboration on its prior restriction requirement regarding claims 1-26, the Office states that "applicant appears to agree that the inventions are not patentably distinct." *Id.* at p. 3. Applicant assures the Office that Applicant does not agree that the inventions are not patentably distinct. Also,
5 Applicant notes that prior arguments are not "moot in view of cancellation of claims 1-9 and 11-26" as stated by the Office. These arguments are part of the official record and Applicant reserves the right to reassert them at a later date.

Rejections under 35 U.S.C. §112

10 Claim 30 stands rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Applicant respectfully disagrees. Nevertheless, Applicant has amended claim 30 for the purpose of advancing prosecution, thereby obviating the ground for the rejection.

15 **Rejections Under 35 U.S.C. §102(e)**

Claims 10 and 28-30 stand rejected under 35 U.S.C. §102(e) as being anticipated by PG-PUB 2003/0140315, filed 7 June 1999, to Blumberg et al. (hereinafter "Blumberg").

Argument

Claim 10 recites a method of providing on-line print services, said method comprising the steps of (emphasis added):

- 5 • receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;
- electronically distributing said at least one order to at least one print service provider facility;
- 10 • within a said print service provider facility, *electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device*; and
- printing said item according to said order, with said printer device, and on said particular sheet material.

15 In making out a rejection of claim 10, the Office states that Blumberg discloses all of the subject matter of the claim, including “electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device”. In particular, the Office states that “Blumberg discloses allocating an item to a printer device based on said printer
20 device having[] said particular sheet material loaded on said printer device. See paragraph[s] 105, 172, for printer devices that print on materials such as clay (mugs), [and] cloth (t-shirts).” (*Office Action of 01/03/06*, p. 6). Applicant respectfully disagrees with the rejection.

 Applicant submits that the Office has failed to state a *prima facie* case of
25 anticipation, as the cited portions of Blumberg fail to disclose all of the elements of Applicant’s claim. For example, Applicant submits that the Office has failed to show how Blumberg discloses “electronically *allocating said item to a printer device* based on said printer device having said *particular sheet material loaded* on said printer device”, as recited in claim 10. (Emphasis added). In claiming that

Blumberg discloses this element, the Office cites Blumberg paragraphs 105 and 172. Both paragraphs are reproduced below (emphasis added):

5 [105] In a preferred embodiment of the present invention, Virtual Builder invokes different *user interfaces* for different modes of operation, such as standard documents, brochures, business cards, letterheads and mugs.

* * *

10 [172] It should be apparent to those skilled in the art that other specialized *display engines* can be added as necessary for other types of products, such as glossy marketing and advertising materials, t-shirts, mugs and mouse pads.

15 As is apparent from the emphasized portions, the above-cited text does not at all disclose “allocating [an] item to a printer device”. Instead, these passages relate to the Virtual Builder *software* of Blumberg, which allows products to be *viewed on a monitor*. According to these passages, this software may include
20 “different user interfaces” or “specialized display engines”. Furthermore, as these passages fail to disclose “allocating [an] item to a printer device”, they certainly fail to disclose “electronically allocating said item to a printer device based on said printer device having said *particular sheet material loaded* on said printer device”. While the Office appears to rely on “clay” and “cloth” as the claimed
25 “material”, Applicant submits that the passages fail to show where these mugs and t-shirts are “*loaded* on [a] printer device”. However, this infirmity is superfluous as the passages fail to disclose any sort of “printer device” at all.

For at least these reasons, the Office has failed to state a *prima facie* case of anticipation. Therefore, Applicant requests the withdrawal of the rejection of
30 claim 10.

Claims 27-30 depend from claim 10, and the rejections of these claims is improper for at least the reasons discussed above in regards in their base claim. In addition, these claims recite features that are not disclosed by the cited portions of Blumberg.

5 For example, dependent claim 29 recites a method as claimed in claim 10, further comprising (emphasis added):

- 10 • *electronically arranging* a plurality of virtual print items on at least one virtual media sheet; and
- *re-sorting* said plurality of virtual print items amongst said at least one virtual media sheet *in a manner which minimizes a number of cuts* applied to said at least one virtual media sheet.

15 In making out a rejection of this claim, the Office states that Blumberg discloses all of the elements of this claim. Specifically, the Office instructs Applicant to “[s]ee for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.” (*Office Action of 01/03/06*, p. 7-8).

20 Applicant traverses the rejection.

Applicant submits that the Office has failed to state a *prima facie* case of obviousness, as the passages cited by the Office fail to disclose the elements of claim 29. First, Applicant submits that paragraph 96 fails to disclose at least the “re-sorting” element of Applicant’s claim. Assuming, without conceding, that the

25 Blumberg template discloses “electronically arranging a plurality of virtual print items on at least one virtual media sheet”, nothing in the passage discloses “*re-sorting* said plurality of virtual print items... *in a manner which minimizes a*

number of cuts". If the Office disagrees, then perhaps the Office can point out with particularity what part of Blumberg discloses this element.

Applicant further submits that the second portion of Blumberg cited by the Office is equally unavailing. Although the Office does not cite to a particular
5 paragraph, the "eight-page booklet" to which the Office refers only appears in paragraphs 9, 40 and 102. Each paragraph is reproduced below (emphasis added):

10 [0009] The present invention provides an on-line on-demand printing service that enables a user to *interactively create and view* a finished document, such as a bound book, an *eight-page brochure* or a customized business card. A user using the present invention can
15 *see on his video monitor how a document will look* as a finished document, with selected front and back covers, selected binding, selected inserts, selected paper type, size and grain, selected imposition, selected folding, selected lamination, selected hole punching, and other selected finishing options. A user using the present invention can also see on his video monitor how a printed product such as a business card will look as a finished document with his own name, company address and logo inserted.

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* * *

25 [0040] The Internet print on demand service of the present invention also uses finished document *templates that enable a user to view, customize and order personalized printing products*, such as stationary, envelopes, business cards, calendars, greeting cards and invitations. A template includes a pre-constructed set of finishing options that are to be applied to a document. Templates are also used
30 *for creating and ordering types of products having styles that a printing company has pre-designed, such as* folders, flyers, four-page glossy brochures, *eight-page brochures* with cut-outs and inserts, and sixteen-page booklets.

* * *

5 [0102] Preferably, the library of available styles is based on a selected print facility, since different print facilities typically offer different selections of styles. Use of templates enables a user to create documents with sophisticated styles, without having to create the style himself. In addition, the styles of templates are preferably designed in such a way that they conform to printing and folding operations that are easy to implement. For example, *an eight-page booklet can be produced by printing on a single large page that is folded in half three times*, cutting appropriate folds and stapling twice in the center. In distinction, when a user designs his own style of document, it may be complicated to produce.

15 Applicant submits that all of the above passages fail to disclose Applicant's claim. Again, even assuming, without conceding, that the Blumberg template teaches "electronically arranging a plurality of virtual print items on at least one virtual media sheet", nothing in the passage discloses "*re-sorting* said plurality of virtual print items". If the Office believes that these passages of Blumberg disclose "re-sorting", then perhaps the Office can point out with particularity what
20 part of the cited text discloses this element.

Furthermore, while the Office appears to principally rely on the emphasized text of paragraph 102, Applicant submits that this language does not disclose "*re-sorting*", and certainly does not disclose "re-sorting said plurality of virtual print
25 items *in a manner which minimizes a number of cuts*". Instead, Blumberg discloses one way in which an eight-page booklet can be produced. Blumberg does not "re-sort", nor even evince a concern for arranging the booklet so as to "minimize a number of cuts".

For at least these reasons, the Office has failed to state a *prima facie* case of
30 anticipation. Therefore, Applicant requests the withdrawal of the rejection of claim 29.

Furthermore, Applicant notes that because the Office has refused to examine independent claim 36 for the reasons discussed above, claim 36 *has not* been rejected. However, Applicant submits that a rejection of independent claim 36 based on reasons similar to claim 29 would be improper for at least the reasons discussed above in regards to claim 29. In other words, if such a rejection *were* to exist, it would be improper as at least failing to show how Blumberg discloses "resorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet." Any rejection of dependent claims 36 and 37 would also be improper for at least this reason.

Rejections Under 35 U.S.C. §103(a)

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in view of Official Notice. However, claim 27 depends from claim 10. Because the "Official Notice" does not cure the deficiencies of the rejection of claim 10, the rejection of claim 27 is improper for least the reasons discussed above in regards to the base claim. Furthermore, claim 27 recites features that are not properly disclosed by the cited portions of Blumberg or by proper Official Notice.

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Conclusion

Applicant respectfully submits that all of the pending claims are in condition for allowance. Accordingly, Applicant requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is anything other
5 than a Notice of Allowability, Applicant requests a phone call to discuss scheduling an interview.

Respectfully Submitted,

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By: Michael K. Colby
Michael K. Colby
Reg. No. 45,816
(509) 324-9256 ext. 240